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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,907	07/11/2001	Veronique Guillou	210231US0	7859
22850	7590	12/22/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			YU, GINA C	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1617

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/901,907	Applicant(s) GUILLOU ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 11, 2005 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 and 13-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukenbach (US 6090773) ("Lukenbach") in view of Derian et al. (US6262130 B1) ("Derian").

Lukenbach teaches a conditioning shampoo or body cleanser composition comprising cationic polymers, an amphoteric surfactant, anionic surfactant, and a nonionic surfactant. See col. 1, line 34 – col. 2, line 59. Amphoteric and anionic phosphate surfactants are disclosed in col. 6, line 56 – col. 10, line 46. The example formula in Table 7 comprises 3.6 % by weight of sodium lauroampho PG-acetate phosphate, acrylamidopropyltrimonium chloride acrylamide copolymer, acrylates/steareth-20 methacrylate copolymer, and polyquaternium-10. Decyl glucoside, a nonionic surfactant, is used in the amount 3.6 % by weight. See instant

claims 5-11, 14. While the “foam height” of the prior art is not explicitly discussed, examiner takes the position that, a composition comprising the same foaming nonionic surfactant used in the instant invention would produce similar foaming property that is within obvious range of the instant claims. The reference teaches that polyquaternium-10 and polyquaternium-7 are preferred conditioning polymers. See col. 10, line 57 – col. 12, line 37; instant claims 16 and 23. The formula also contains glycerin. See also col. 14, line 44 – col. 15, line 2; instant claim 17. The reference further teaches using thickening agents. See col. 14, lines 4 – 27; instant claim 18. The claimed method of using the composition is viewed an expected use of the prior art. See instant claims 19-22.

While the Lukenbach invention employs cationic polymers containing saccharide such as polyquaternium-10 and guar hydroxypropyl trimonium chloride, the reference teaches that polyquaternium-7 or polyquaternium -6, (cationic polymers devoid of saccharide) are functional equivalent to these polymers. It is well settled in patent law that it is prima facie obvious to substitute equivalents known for the same purpose. See MPEP § 2144.06. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted polyquaternium 10 and guar hydroxypropyl trimonium chloride, with polyquarternium-7 and/or polyquaternium –6 because of the expectation of successfully producing a cleansing composition with similar conditioning effects.

The term “consisting essentially of” in instant claim 1 is treated same as “comprising” in absence of applicants’ showing that the presence of the unrecited

components would materially alter the basic and novel characteristic of the claimed invention. See PPG Industries v. Guardian Industries, 156 F.3d 1351, 1355, 48 U.S.P.Q. 2d 1351, 1355 (Fed. Cir. 1998). Claims 24 and 25 do not exclude other components present in the prior art, such as amphoteric surfactants.

Lukenbach generally teaches alkyl phosphate surfactants, disclosed in col. 10, lines 16 – 42. The reference fails to teach using the specific phosphate surfactants of the instant claims 4 and 16.

Derian teaches aqueous surfactants comprising alkyl phosphate ester salts useful in formulating flowable or pumpable transparent gels. See abstract; col. 1, line 19 – col. 2, line 55. Potassium salt of dodecyl phosphate is disclosed. See instant claims 4 and 16. The reference teaches that the alkyl phosphate ester salts are useful in cosmetic and personal care products because of their foaming properties, detergency, non-irritating properties, form density, stability and skin feel. The reference also teaches that the invention does not require the presence of such undesirable other surfactants or large amounts of co-solvents or alcohols or other additives. See col. 2, lines 26 – 36. The invention, which is pumpable and transparent, is also said to allow minimize the amount of co-solvents or other surfactants. See col. 3, line 10 – col. 4, line 44. Although both references are silent as to the measurement of the actual foam height of the inventions, examiner takes the position that, in view of the fact that prior art which meet the limitations of the instant claims, the claimed properties of the instant inventions may be due to the limitations not disclosed in the instant claims.

Given the general teaching of using phosphate surfactants in Lukenbach, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the prior art such as Derian for specific phosphate surfactants. The motivation to have modified the Lukenbach composition by substituting the anionic surfactants with the phosphate surfactants of Derian would have been obvious to the skilled artisan because of the expectation of successfully producing a transparent cleansing composition with good foaming properties, detergency, non-irritating properties while minimizing the need of co-surfactants.

Oath/Declaration

In the Rule 132 declaration filed on Aug 26, 2004, the data shows a comparison between a composition comprising phosphate surfactant, decyl glucoside, and polyquaternium 47 (devoid of saccharide), and a comparison composition comprising the same components but no cationic polymers at all. While the data shows different numerical values obtained in each of the "sensory criteria" of foam volume, size of bubbles, and density of foam between these two compositions, firstly it is not clear what those numbers represent or how they were measured. Secondly, it is not clear whether these differences would have been obtained by comparing the present invention with a composition comprising a cationic polymer comprising saccharide in the same condition.

Applicants assert that the Rule 132 declaration filed on April 25, 2002 shows that cationic polymer containing a saccharide group "negatively affects the rinsibility and viscosity of the composition". However, it is noted that in the comparison example, the

cationic polymers are not the only variables. While the comparison example using polyquaternium-10 employs 3.35 A.M. (amounts of active material) and 10.5 A.M., respectively, these compounds are used by 6.5 A.M. each in the example using polyquaternium-7 (devoid of saccharide). Thus, it is not clear whether the alleged superior results of rinsibility and viscosity is attributed to of cationic polymers devoid of saccharide as asserted, or due to the other components present in different amounts.

Response to Arguments

Applicant's arguments filed on October 11, 2005 have been fully considered but they are not persuasive.

Examiner notes that the Lukenbach teaches making cleansing composition by combining cationic polymers, including those with or without saccharide group; and anionic surfactants including monoalkyl phosphate components. Derian is cited to show that applicant's specific phosphate surfactant, potassium dodecyl phosphate, is well known to skilled artisans for its specific advantages in cleansing compositions, including improved foaming density, etc. Thus examiner takes the position that it is expected that the claimed invention has good foaming properties, and detergency.

With respect to the 132 declaration filed on March 9, 2005, applicants explain that the numbers in the data indicates the grade attributed increases as the volume increases, and indicates "relative differences among the tested compositions". However, examiner is not convinced that these numerical differences are so significant that amounts to unexpected results.

Examiner maintains the rejection also in light of the legal precedents. The court in Atlas Powder Co. v. Ireco Inc held, "the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." See 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. See In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." 596 F.2d at 1022, 201 USPQ at 661.); In re Baxter Travenol Labs., 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Appellant argued that the presence of DEHP as the plasticizer in a blood collection bag unexpectedly suppressed hemolysis and therefore rebutted any prima facie showing of obviousness, however the closest prior art utilizing a DEHP plasticized blood collection bag inherently achieved same result, although this fact was unknown in the prior art.). The fact that appellant has recognized another

advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.”

See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In this case, the prior arts teach making the claimed composition. Although Lukenbach does not distinguish the effects of using saccharide-containing cationic polymers as opposed to non-saccharide-containing cationic polymers, using the latter type of polymer as required by applicants is nevertheless taught in the prior art. While applicants assert that the polymer unexpectedly benefits such as better rinsibility and bubble size, those properties are latent advantages of an old and obvious composition that is not patentable.

Conclusion

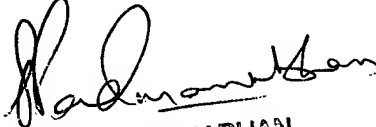
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 6:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER